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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,743	11/26/2003	Hans-Dieter Gaul	DT-6688	8970

30377 7590 03/06/2006  
DAVID TOREN, ESQ.  
ABELMAN FRAYNE & SCHWAB  
666 THIRD AVENUE  
NEW YORK, NY 10017-5621

EXAMINER
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GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,743

Applicant(s)

GAUL, HANS-DIETER

Examiner

Jennifer H. Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hornschuch et al. (US 3,608,131, referred to hereafter as Horn).

*Regarding claim 1:* Horn discloses a tool holder for an impact wrench (the examiner notes that the tool holder disclosed would be capable of being used with an annular core bit). The tool holder includes a bit-side axial stop-surface (the bottom surface of element **25** as shown in Figure 1); and an end-side splined profile **30** extending in a bit direction and having an outer thread **31** forming radial spline projections of the splined profile.

*Regarding claim 2:* At least one of an outer thread dimension and a dimension of inner grooves of the splined profile defines a radial guide dimension that extends over an axial guide length, which is larger than the radial guide dimension.

*Regarding claims 3-6:* The splined profile has a plurality of equidistantly circumferentially spaced, axial grooves that have the same circumferential width. As shown in Figure 5, there are at least six axial grooves.

*Regarding claim 7:* The tool holder further includes a tool-side axial stop surface (top surface of element **25**) axially spaced from the bit-side axial stop surface, and a sleeve **16** having an inner thread and provided on a tool-side of the tool holder, the sleeve overlapping the tool-side stop surface in a spaced relationship thereto.

*Regarding claims 8, 9:* The tool holder further includes an axial conical surface **17** extending from the bit-side axial stop surface in a tool direction and is axially limited by the bit-side axial stop surface and the tool-side axial stop surface.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn.

*Regarding claim 10:* Horn discloses all of the limitations of the above claim(s) except for except for the tool holder including a rubber ring provided between the sleeve and the tool-side axial stop surface.

However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the tool holder of Horn to include a rubber ring between the sleeve and the tool-side axial stop surface in order to have both provided a seal between the elements and reduced the friction therebetween.

*Regarding claim 11:* Horn discloses a tool assembly for core drilling, comprising a tool 12, 33; and a tool holder for the tool and having a bit-side axial stop surface (bottom surface of element 25 as shown in Figure 1), and an end-side splined profile 30 extending in a bit direction and having an outer thread 31 forming radial spline projections of the splined profile, the tool having an inner splined profile (3:29-32) complementary to the end-side splined-profile of the tool holder.

However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the tool holder of Horn with an annular core bit as the holder would have worked equal well with an annular core bit while still providing the torque control the spline connection provides.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

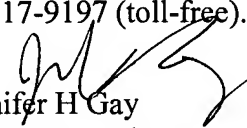
Art Unit: 3672

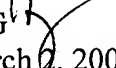
**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H Gay  
Primary Examiner  
Art Unit 3672

JHG   
March 2, 2006